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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,727	04/11/2001	Toshihide Wada	1232-4705	9738
27123	7590	03/09/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			GIBBS, HEATHER D	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/832,727		WADA, TOSHIHIDE	
	Examiner		Art Unit	
	Heather D Gibbs		2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 21 and 26 is/are rejected.
- 7) ☒ Claim(s) 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/02/05</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2622

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-19,24-25, drawn to an electric part to be connected to a main apparatus, classified in class 360, subclass 137.
 - II. Claims 20-23,26, drawn to an optical part for forming an image on an image-sensing device, classified in class 358, subclass 472.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the electric part is broad as compared to the optical part. The subcombination has separate utility such as the optical part forms an image on an image-sensing device.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention: an electric part to be connected to a main apparatus.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally

Art Unit: 2622

held to be allowable. Currently, an electric part to be connected to a main apparatus is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Stephen Manetta (Reg. 40,426) on February 16, 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 20-23,26. Applicant in replying to this Office action must make affirmation of this election. Claims 1-19,24-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 2622

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

7. Claims 20,26 recites the limitation "said image sensing device of said optical part" in Page 44 Lines 27 and Page 48 Line 21. There is insufficient antecedent basis for this limitation in the claim. Per applicant's request, the antecedent basis has been amended so as to overcome the rejection. Applicant is still required to officially amend the claim within the next Office action sent.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 20-21,26 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanai et al (US 5,561,743).

Regarding claim 20, Kanai discloses an optical part for forming an image on an image sensing device comprising: an image sensing device (Col 5 Lines 20-37); a first cylindrical member 13 holding a first lens; a second cylindrical member 12 holding a second lens having the same optical axis as said first lens; a third cylindrical member for determining the position of said image sensing device in the direction of said optical axis 16 (Col 6 Lines 40-45); an externally operable first adjusting mechanism for continuously

Art Unit: 2622

adjusting and fixing the position of said second cylindrical member with respect to said first cylindrical member along said optical axis (Col 8 Lines 26-34); and an externally operable second adjusting mechanism for stepwise adjusting and fixing the position of said third cylindrical member with respect to said first cylindrical member along said optical axis (Col 9 Lines 5-19), wherein an amount of adjustment by said second adjusting mechanism is determined in accordance with a stepwise selectable pivoting angle of said third cylindrical member around said optical axis (Col 9 Lines 20-42).

Regarding claim 21, Kanai teaches The optical part according to claim 20, further comprising a third adjusting mechanism for fixing said image sensing device to said third cylindrical member by pivoting said image sensing device on said optical axis (Col 8 Lines 48-61; Figs 7,17).

Considering claim 26, Kanai teaches a processing apparatus comprising: a main apparatus; and an optical part capable of being attached and detached from said main apparatus, wherein said optical part comprises: an image sensing device (Col 5 Lines 20-37); a first cylindrical member 13 holding a first lens; a second cylindrical member 12 holding a second lens having the same optical axis as said first lens; a third cylindrical member for determining the position of said image sensing device in the direction of said optical axis 16 (Col 6 Lines 40-45); an externally operable first adjusting mechanism for continuously adjusting and fixing the position of said second cylindrical member with respect to said first cylindrical member along said optical axis (Col 8 Lines 26-34); and an externally operable second adjusting mechanism for stepwise adjusting and fixing the position of said third cylindrical member with respect to said first cylindrical member along said optical axis (Col 9 Lines 5-19), an amount of adjustment by said second adjusting mechanism is

Art Unit: 2622

determined in accordance with a stepwise selectable pivoting angle of said third cylindrical member around said optical axis (Col 9 Lines 20-42), and said main apparatus processes an image signal provided by said image sensing device of said optical part (Col 5 Lines 19-37).

Allowable Subject Matter

10. Claims 22-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Objections

11. Claim 23 is objected to because of the following informalities: sentence should read "...capable of mounting a printhead instead of a scanner head". Appropriate correction is required.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kanai et al (US 5,450,211) Image Forming Apparatus and Method for Maintaining Set Magnification Not Withstanding Changes in Optical System Due to Temperature Change.

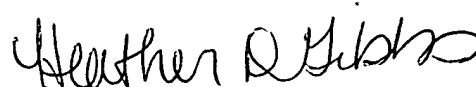
Higuchi et al (US5, 953,188) Electric Apparatus Having a Synthetic Resin Upper Cover and Shield Plate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

Art Unit: 2622


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Heather D Gibbs
Examiner
Art Unit 2622

hdg



EDWARD COLES
SUPERVISOR/ART UNIT EXAMINER
TECHNICAL STAFF